

REMARKS

In light of the above amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-9 are pending in this application and are rejected in the Office Action. In this response, claims 1, 2 and 4 have been amended.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112, but rather the amendments and remarks made herein are simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication No. WO 03/097181 to McGrath et al. (“McGrath”). The rejections are traversed for at least the following reasons.

Initially, in an effort to more particularly point out the features of the present invention, claims 1 and 2 have been amended to limit the interface portion to an adhesive material.

Revised claim 1 of the present invention is directed towards a fiber reinforced, resin composite hockey stick blade member, comprised of an elongated hollow blade body with an adhesive material disposed between the blade body and a cork damping portion that is contained within the blade body.

Claim 1 of McGrath is directed towards a cured composite blade for a hockey stick comprising a front facing wall and a back facing wall that are spaced apart at their mid sections

forming a cavity in between. The walls are formed of one or more plies of continuous fibers embedded in a resin matrix. Within the cavity is encased one or more inner core elements formed of an elastomeric material.

In the Office Action, the Examiner admitted that “the use of cork as the flexible damping portion” in a blade member is not disclosed in McGrath. However, the Examiner took Official Notice that cork is a commonly known material, which provides a damping function. The Examiner also took Official Notice “that the claimed materials including foam are commonly known elastomer materials and would have been suitable for McGrath’s purposes.” Applicant respectfully disagrees on both accounts and requests that references be provided to support the Examiner’s claims. It is error for the Examiner to merely assert that a claimed element not found in the cited art is well known in the art if no reasons or authorities are relied upon for support. With regard to the use of Official Notice, reference is made to *In re Pardo and Landau*, 214 U.S.P.Q. 673 (C.C.P.A. 1982) in which the court states:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the applicant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.

Id. at 677 (citing *In re Ahlert*, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)). In view of *In re Pardo and Landau* and *In re Ahlert*, it is improper for the Examiner to fail to cite a reference that specifically describes the invention as recited in the claims. Furthermore, the Examiner took Official Notice that foam is a commonly known elastomer. However, McGrath states, “at least another of the inner core elements is non-elastomer material such as foam.” Page 4, lines 27-28. Moreover, on page 16 in McGrath, foam and elastomer materials are described separately which

indicates that foam is not an elastomer. Therefore, McGrath contradicts the Examiner's statement.

The Examiner also states that McGrath makes clear that any core material may be used and that in view of the use of suitable materials, it would have been obvious to one of ordinary skill in the art to use cork. Again, Applicant respectfully disagrees. For the core materials, McGrath specifically teaches the use of foam and elastomer or rubber. *See* page 16, lines 1-35. These materials do not encompass cork. In fact, McGrath specifically teaches away from cork. McGrath teaches an elastomer or rubber material for the core where the term elastomer "is defined as, or refers to, a material having properties similar to those of vulcanized natural rubber, namely, the ability to be stretched to approximately twice its original length and to retract rapidly to approximately its original length." Page 16, lines 17-20. Cork cannot be stretched to approximately twice its original length since its modulus of elasticity is much less than that of rubber. Therefore, based on the teachings of McGrath, one of ordinary skill in the art would have been lead away from using cork as a core material.

In addition, the specific core materials of elastomer, foam and rubber as taught in McGrath, have lower coefficients of restitution inside the blade member than that of cork as outlined in the attached test results titled "Coefficient of Restitution." Furthermore, since cork is not a dense material, it is a relatively light material. Therefore, the overall weight of the blade member of the present invention can be reduced by 15-40% as compared to that of previous blade members. As stated in McGrath, elastomer materials have significantly greater densities than conventional foam materials and thereby add to the weight of the hockey stick. Page 17, line 32 to page 18, line 1. To combat the increased weight, McGrath discloses placing the elastomer materials in "discrete strategic locations" in the blade as depicted in Fig. 20. *See* page

18, lines 1-10. Since, cork is lightweight, there is no need to place cork at discrete locations in the blade in order to reduce weight. However, the damping effect of the present invention may be increased by embedding an impact-absorbing member in the cork as disclosed in claims 4-9 of the present invention. Therefore, these differences between the properties of cork and the core materials disclosed in McGrath, further support that the use of cork would not be obvious to a person of ordinary skill in the art.

Accordingly, since McGrath teaches away from using cork as a core material, it is respectfully submitted that revised claim 1 is not obvious and is thereby patentable over McGrath. Since claims 2-9 depend from claim 1, they are patentable as well. Consequently, reconsideration and withdrawal of the Section 103 rejections are earnestly requested.

In the event, that the Examiner disagrees with any of the foregoing comments concerning the disclosures in the cited prior art, it is requested that the Examiner indicate where, in the reference or references, there is the basis for a contrary view.

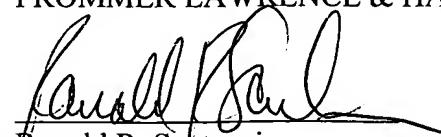
CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

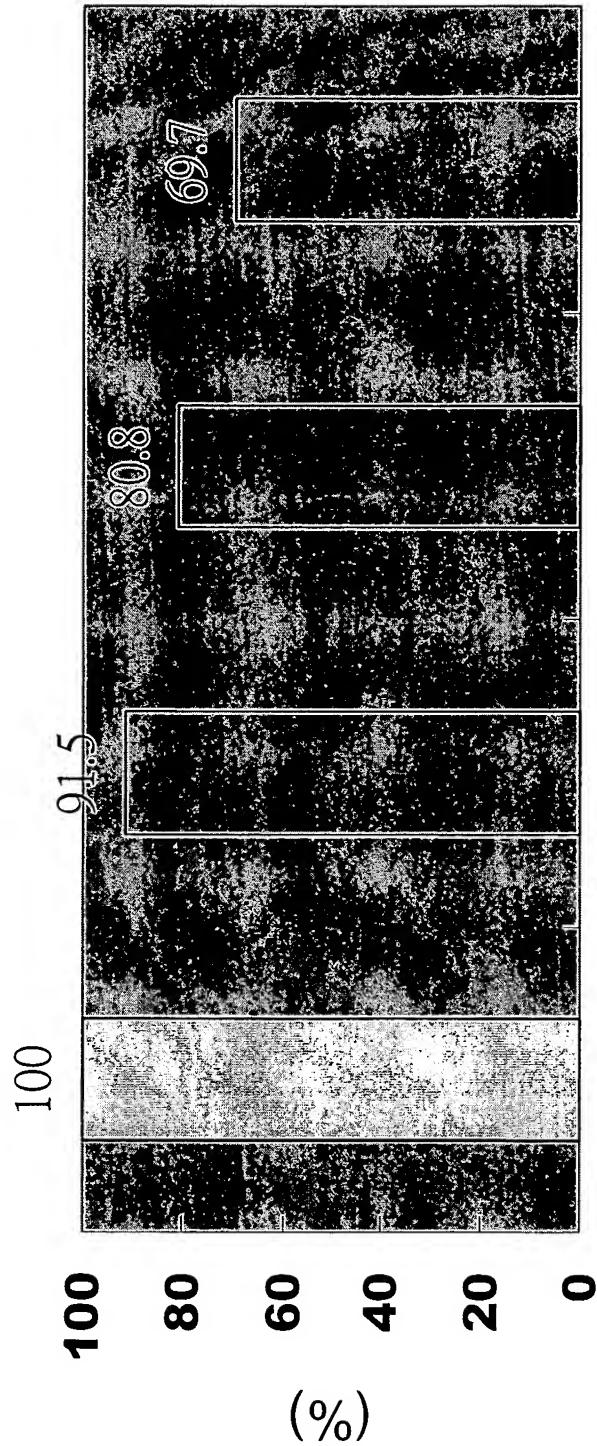
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Coefficient of Restitution



The Coefficient of Restitution for different core materials inside the blade.